

Two paragraphs introduced to describe Figs. 71-74 are rejected under 35 U.S.C. 132 for introducing new matter.

Claims 34, 25, 40, 43, 47-50 77, 82 and 84-88 are rejected under 35 U.S.C. 101 for claiming non-statutory subject matter.

The following claims are rejected under 35 U.S.C. 102 (b):

1. Claims 34, 35, 40 and 43 for being anticipated by Dzus (U.S.P. 2,485,531);
2. Claims 34, 35, 40 43 and 83-86 for being anticipated by Tennican (U.S.P. 3,168,50); and
3. Claims 34, 40, 82, 83 and 85 for being anticipated by Ferris U.S.P. 4,865,501)

### **Response to Office Action mailed 24 April, 2003**

#### **I. Scope of elected species**

Applicant has cancelled claims 78-81 and 88-92 but reserves the right to recover the material in these claims in future continuation and/or divisional applications related to the instant application.

#### **II. Old Matter presented in a Figure**

Page 31, lines 2 and 3 state that the geometry of head embodiment (H4) is "especially useful if the surrounding tissue is very thin and devoid of muscle and/or fat, such as on the forehead or the front of the shin". This statement clarifies Figs. 72 and 73 in that (Claim 34) "the other faces adjoining the first face and contacting the surface each have a smaller area than said first area".

Clearly, Figs. 72 and 73, particularly with the above-noted description, are within the scope defined by *Vas-Cath Inc. v Mahurkar* 935F.2d 1555, 1563, 19 SUPZ2d 1498 (Fed. Cir. 1998), "Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed."

#### **III. Statutory Subject Matter**

Applicant has amended claims 34 and 82 to remove the following references:

"contacts a ... bone" and "contacts the bone", claim 34; and

"contacts a bone", claim 82,

thereby complying with the examiner's interpretation of 1146 TMOG 24 (1993).

With claims 34, and 82 in allowable form, dependent claims 35, 40, 47-50, 77, 84-88 thereby become allowable.

#### **IV. Adjoining Faces**

Applicant has amended claim 34 have been amended to use the word "face" in place of the word "surface".

Webster's Encyclopedic Unabridged Dictionary Updated Version, defines "face" as:

"any of the *bounding* surfaces of a solid figure; a cube has six faces."

On this basis, claim 34 has been broadened and thereby defines a different invention with respect to Dzus (U.S.P. 2,485,531).

#### **V. Fasteners Adapted to be Sterilized**

Examiner finds:

i) Claims 34, 35, 40 43 and 83-86 are anticipated by Tennican (U.S.P. 3,168,50); and

ii) Claims 34, 40, 82, 83 and 85 are anticipated by Ferris (U.S.P. 4,865,501).

Applicant has amended independent claims 34, 82 and 83, to specify a fastener "adapted to be sterilized".

That these fasteners must be sterilized prior to implantation as stated on Page 21, lines 14-21 of the instant application:

"The entire fastener is characterized by suitable incorporation of... materials of long-term biological stability ... well tolerated by the body both during healing and thereafter, and to be extremely unlikely of ... reaction within the joints or the body as a whole."

Non-sterilized fasteners implanted in body tissue cause infections that are not tolerated well by the body, causing infection that can result in death.

Neither Tennican nor Ferris teach devices that are "adapted to be sterilized".

With claims 34, 82 and 83 allowable, dependent claims 35, 40, 43, 84-86 and 93-98 become allowable.

**VI. Multiple Dependencies**

Applicant has revised claims 47, and 84-88, to remove multiple dependencies, and added claims 93-98, thereby recovering the material sacrificed in removing multiple dependencies of claims 84-88.

**Response to Office Action of 19 February 2004**

In the subject Office Action, Examiner rejected Applicant's response (13 January 2004, paper # 21) to an Office Action mailed 24 April 2003 and finds that Applicant "deliberately submitted" a response containing errors in the amended claim set. Examiner has awarded Applicant "a new time period for reply" of six months as provided by 37 CFR 1.134 and 1.135c.

Applicant respectfully submits that were the proposed claims "inadvertently omitted" and Applicant is entitled to consideration under 37 CFR 1.135c based upon the following:

i) A Patent Office error vis-à-vis the Applicant's timely response to the Office Action mailed 24 April 2003 resulted in a 30 day deadline to formulate the response above-noted inadvertent response. Applicant is neither a Patent Attorney or Patent Agent and due to the tremendous time pressure made *non-substantive* errors.

ii) The claims contain an error in the *cancelled portion* of claim 34 as filed in the RCE of 17 March 2003, but *not* the amended portion of claim 34. Additionally, while claims 48, 49 and 50 were inadvertently included, these claims had been, in fact, "previously cancelled", rendering their inclusion *non-substantive*.

In light of the above inadvertent non-substantive additions and the error of the USPTO, Applicant respectfully requests that no charges or penalties be levied in association with the instant response.

**Summary**

In view of the above remarks and amendments, a positive IPER is respectfully awaited. In the event that the Examiner believes that there are problems that would make it impossible to allow the claims, the Examiner is respectfully requested to call the undersigned at: (972) 56-758-096 so these issue can be reviewed and/or clarified. Please note that Israel is 7 hours ahead of the US East Coast.

Alternatively, please use the address listed below for sending correspondence to the Applicant.

Respectfully submitted,

  
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